

## REMARKS

This Application has been reviewed in light of the Office Action mailed January 24, 2008. At the time of the Office Action, Claims 1-9, 11, 12 and 24-26 were pending in this Application. Claim 26 was allowed and Claims 1-9, 11, 12 and 24-25 were rejected. Claim 1 has been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

### **Rejections under 35 U.S.C. §112**

Claims 1-9 and 24 were rejected by the Examiner under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claim 1 has been amended to further clarify the subject matter described. Support for this amendment may be found at least in, for example, paragraphs [0022] and [0056] of the Specification as originally filed. With regard to claim 9, the presence of "six slits disposed about the circumference of said outer peripheral wall" is described by the Applicants at least impliedly in paragraphs [0062], [0063] and [0067] of the Specification as originally filed, where the formation of a plurality of slits (and specifically preferably six) in a cylindrical body is taught. Therefore, Applicants respectfully submit that the present application adequately describes the claimed invention. Applicants thus respectfully request favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 112.

### **Drawing Objections**

Examiner has objected to the drawings for not showing every feature of the invention specified in the Claims under 37 CFR 1.83(a). Applicants respectfully submit that the drawings at least impliedly point out at least one example of the feature of a "larger cross-section." For example, in the Specification as filed at paragraph [0065], Applicants state that "[t]he creation of . . . semi-circular geometry in the ribs 86 increase the body diameter of the bone anchor 80 such that the aggregate outside diameter of the deformed ribs 86 is substantially larger than the normal diameter of the cylinder body." (Emphasis added). Thus, the description of a substantially larger outside diameter of the deformed ribs 86 at least impliedly describes a larger cross-section, such that the feature is thereby illustrated in the drawings by at least ribs 86 in Fig. 10. Applicants thus respectfully request favorable reconsideration and withdrawal of the rejection.

**Rejections under 35 U.S.C. §103**

Claims 1-9, 11-12 and 24-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,156,056 issued to Kearns et al. ("Kearns"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

When determining whether a claim is obvious, the Examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well settled that obviousness requires at least a suggestion of all the features in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, "*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

With respect to Claim 1, Kearns does not disclose a device where a portion of the peripheral wall is radially enlarged relative to the longitudinal axis such that the apparatus has a larger cross-section in the second configuration than in the first configuration, as is now described by amended claim 1. Rather, the device disclosed by Kearns is bent such that the outer peripheral wall is arcuately expanded. Moreover, the device described in Kearns does not exhibit any radial expansion relative to the longitudinal axis of the device, as the distance between the longitudinal axis and outer radius remains constant as the device is manipulated between a first unbent configuration and a second bent configuration. Therefore, Kearns does not suggest all of the features of claim 1 as amended, and cannot render obvious amended claim 1. Applicants respectfully submit that claim 1 as amended is in condition for allowance, and request withdrawal of the rejection.

Claims 2-9 and 24-25 depend directly or indirectly from amended claim 1. Applicants repeat and hereby incorporate the above remarks regarding amended claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In*

*re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully submit that claims 2-9 and 24-25 are in condition for allowance, and request withdrawal of the rejection.

With regard to claim 11, Kearns does not disclose slits in an outer peripheral wall of a body that are longitudinally disposed. Rather, Kearns describes slits that are radially disposed. Additionally, Applicants point out that claim 12 depends directly from claim 11, and hereby incorporates the above remarks regarding claim 11. Applicants respectfully submit that Kearns cannot render obvious claims 11-12, and request favorable reconsideration and withdrawal of the rejection.

**Allowable Subject Matter**

The Examiner has indicated that Claim 26 is allowed over the art of record.

**Information Disclosure Statement**

Applicants enclose an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner's review and consideration.

### CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$180 for the IDS to Deposit Account No. 50-0359 of ArthroCare Corporation.

Applicants believe there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted  
Attorney for Applicants,



Matthew Scheele  
Reg. No. 59,847

Date: 7/22/08

CORRESPONDENCE ADDRESS:

ARTHROCARE CORPORATION

CUSTOMER NO. **21394**

512.358.5925

512.391.3901 (fax)

Enclosure: 1) Information Disclosure Statement and PTO Form 1449, with copies of the references.